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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,274	12/12/2000	L. Michael Maritzen	SONS180.02A	7901

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O'BANION & RITCHIE LLP/ SONY ELECTRONICS, INC.  
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[REDACTED] EXAMINER

ELISCA, PIERRE E

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

3621

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/737,274</b>	Applicant(s) <b>L. Michael Maritzen et al</b>
	Examiner <b>Pierre E. Elisca</b>	Art Unit <b>3621</b>
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
<b>Period for Reply</b> A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>THREE</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
<ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>		
<b>Status</b> <p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>6/26/2003</u></p> <p>2a) <input type="checkbox"/> This action is FINAL.      2b) <input checked="" type="checkbox"/> This action is non-final.</p> <p>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11; 453 O.G. 213.</p>		
<b>Disposition of Claims</b> <p>4) <input checked="" type="checkbox"/> Claim(s) <u>1-23</u> is/are pending in the application.</p> <p>4a) Of the above, claim(s) _____ is/are withdrawn from consideration.</p> <p>5) <input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6) <input checked="" type="checkbox"/> Claim(s) <u>1-23</u> is/are rejected.</p> <p>7) <input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.</p>		
<b>Application Papers</b> <p>9) <input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10) <input type="checkbox"/> The drawing(s) filed on _____ is/are a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p>11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.</p> <p>12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>		
<b>Priority under 35 U.S.C. §§ 119 and 120</b> <p>13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:</p> <ol style="list-style-type: none"> <li>1. <input type="checkbox"/> Certified copies of the priority documents have been received.</li> <li>2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</li> <li>3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> </ol> <p>*See the attached detailed Office action for a list of the certified copies not received.</p> <p>14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).</p> <p>a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.</p> <p>15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.</p>		
<b>Attachment(s)</b> <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). <u>7</u></p> <p>4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____</p>		

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**DETAILED ACTION**

**RESPONSE TO AMENDMENT**

1. This Office action is in response to Applicant's Response, filed on 06/26/2003.
  
2. Claims 1-23 are presented for examination.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. **Claims 1-8, 11-20, and 23 are rejected under 35 U.S.C. 102 (e) as being anticipated by Johnson (U.S. Pat. No. 6,529,885).**

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**As per claims 1, 5-8, 11-20, and 23 Johnson discloses an inventive concept of carrying out electronic transactions including electronic drafts, wherein payment on at least one of the drafts is contingent upon the removal of an associated contingency (which is equivalent to Applicant's claimed invention wherein it is stated that a system for performing electronic commerce transactions), comprising:**

a transaction terminal configured to receive a user transaction device that provides a device identifier when coupled to the transaction terminal, said transaction terminal further configured to indicate that a transaction is to be performed (see., figs 1A and 1B, col 9, lines 5-67, col 10, lines 1-60);

a transaction privacy clearinghouse configured to communicate with the transaction device when a transaction is to be performed, said transaction privacy clearinghouse further configured for receipt of said device identifier and capable thereupon of authorizing a transaction on behalf of a user associated with said device identifier after the identity of said user has been verified (see., abstract, specifically wherein it is stated that parties and contingency approvers requesting access to the computer site are authenticated by encrypting identification information, and also Johnson does teach clearinghouses that form an integral part of negotiating a conventional paper check see., 7, lines 26-64); and

an escrow account associated with the transaction privacy clearinghouse which is configured for receiving and dispersing forms of remuneration associated with authorized transactions (see., col 24, lines 43-67, col 25, lines 1-28).

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**As per claims 2, 3, 4, and 22 Johnson discloses the claimed limitations of executing unit configured to automatically perform a transaction upon receiving a selected invoice or bill from a vendor that meets certain predetermined verification criterion (see., col 3, lines 9-29, specifically wherein it is stated that make payment or bill as the contingencies are met).**

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 9, 10, and 21 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Johnson in view of Biffar (U.S.Pat. No. 6,047,269).**

**As per claims 9, 10, and 21 Johnson discloses the claimed limitations as stated in claims 8, 6 and 1 above. It is to be noted that Johnson fails to explicitly discloses an incentive unit or coupon, digital currency. However Biffar discloses a self-contained payment which includes a voucher at a time of transaction such as coupons (see., col 5, lines 23-27). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the electronic transactions of Johnson by including the incentive process taught by Biffar because such modification**

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would provide the electronic transactions of Johnson with the enhanced capability of creating digital coupons or voucher or incentive which will facilitate a fast electronic transaction.

**REMARKS**

7. In response to applicant's arguments, Applicant argues that the prior art of record taken alone or in combination fail to disclose: "a transaction with a device identifier, a clearing house, and an escrow account associated with the clearing house". However, the Examiner respectfully disagrees because these limitations are disclosed in figs 1A and 1B, col 9, lines 5-67, specifically secure socket layer or device identifier, and col 24, lines 43-67, col 25, lines 1-28, please note that buyer's home bank is interpreted as a clearing house.

***Conclusion***

8. Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Tuesday to Friday from 6:30AM. to 5:00PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768.

**Any response to this action should be mailed to:**

Commissioner of patents and Trademarks

Washington, D.C. 20231

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The Official Fax Number For TC-3600 is:

**(703) 305-7687**



Pierre Eddy Elisca

Patent Examiner

**August 29, 2003**